

REMARKS

In the Office Action mailed June 6, 2006, the Examiner rejected claims 28-47. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 28, 33, 40, 46 and 47, canceled claims 31, 32 and 37 and added new claims 48-50. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Priority

Applicants have amended the specification to include a claim of priority as suggested by the Office Action.

II. Specification

The Office Action requests that the title of the application be changed to reflect the claims. Such change has been made.

III. Drawings

The Office Action objected to the drawings for failing to include the reference numeral "18", which is mentioned in the description. In response, Applicant has change each occurrence of the reference numeral "18" in the description to read "16" such that the drawings have proper reference numerals.

IV. Information Disclosure Statement

The Office Action suggested non-consideration of several references for failure to submit copies of those references with the IDS. Applicants suggest that those references were submitted with the parent application to the present application. However, for the assistance of the Examiner, those references indicated as not considered have been submitted herewith in a supplemental information disclosure statement

V. Claim Rejections – 35 USC 112

The Office Action suggests that claim 46 is incomplete, however, it appears that an “and” was inadvertently placed at the end of that claim and has been removed by amendment.

The Office Action suggests that the recitation of “the thermally activated polymeric material” lacks antecedent basis in claim 47. Claim 47 has been amended to cure this lack of antecedent basis.

VI. Claim Rejections – 35 USC 102/103

The Office Action rejected claims 28-47 being anticipated by or obvious in view of Ward et al. (US 3025596), hereinafter referred to as Ward, and/or Wycech (US 5884960), hereinafter referred to as Wycech. Without acquiescing in any of these rejections, Applicants have amended claims 28 and 40 and believe that claims 28 and 40 and their dependents are patentable. Applicants have not materially amended claims 46 and 47 and traverse the rejection of claim 46 and 47 with particularity.

The Law

The MPEP sec. 2131 quotes Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987) as reading, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

The MPEP 2143.03 reads, “To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art.” In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching.” Id. It must be based on objective evidence of record.

This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");... The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 28

Claim 28 has been amended to add language suggesting that the "adhesive structural material includes epoxy". Ward, at best, discloses the use of a metal powder and a cementing agent for use with a brazing technique. Applicants contend that the language added to claim 28 provides additional distinction relative to Ward since brazing as an attachment technique is quite different from the use of an adhesive material with an epoxy. Applicants request that the rejections of claim 28 and its dependents be withdrawn.

Claim 40

Claim 40 has been amended to add language suggesting, "the hydroforming includes injecting a liquid under pressure into the bore such that an outer surface of

the first structure assumes a shape of a mold". Ward, at best, discloses a "special mandrel 24 driven ... by ... hydraulic pressure" (col. 4, lines 24-26) for providing "intimate joint contact prior to brazing" (col. 3, lines 72-75). Applicants contend that the language added to claim 40 provides additional distinction relative to Ward since nothing in Ward suggests a hydroforming process as recited in claim 40. Applicants request that the rejections of claim 40 and its dependents be withdrawn.

Claim 46

Claim 46 has not been materially amended and Applicants traverse the rejection of claim 46 on the grounds that the Office Action has not established a prima facie case of obviousness against claim 46. In particular, the Office Action suggests at page 7 thereof, that "official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention to use tubular structures for vehicles, in order to provide frame structures, piping or tubing". This statement, however, provides no indication that structures such as those formed in Ward are used in automotive vehicles and provides no motivation for using the structures of Ward in a vehicle. As such, Applicants contend that the Office Action has failed to establish a prima facie case of obviousness against claim 46 of the present application and Applicants request that the rejection of claim 46 be withdrawn.

Claim 47

Claim 47 has not been materially amended and Applicants traverse the rejection of claim 47 on the grounds that the Office Action has not established a prima facie case of obviousness against claim 47. In particular, the Office Action suggests at page 7 thereof, that "it would have been an obvious matter of design choice ...to have performed adhering after hydroforming because applicant has not disclosed that adhering being performed after hydroforming provides an advantage, is used for a particular purpose, or solves a stated problem." Applicants assume that the Office Action meant to suggest adhering or bonding prior to hydroforming since that is how claims 39 and 47 actually read. Either way, the Office Action provides no indication that such adhering prior to hydroforming is even known in the prior art and the Office

Action provides no motivation for performing such adhering prior to hydroforming. Furthermore, in claim 47, such adhesion prior to hydroforming, at least locates the adhesive relative to the tubular structures prior to contouring, which can make such locating more difficult. Moreover, and the adhesion prior to hydroforming may also function to assist in locating the tubular structures relative to each other. In view of the above, Applicants request that the rejection of claim 47 be withdrawn.

VII. Terminal Disclaimer

The Office Action rejected the claims for obviousness type double patenting over the claims of US Patent 6,668,457. Applicants submit herewith a terminal disclaimer to overcome the rejection.

VIII. New Claims

Applicants have added claims 48-50 and believe that those claims are patentable over the references of record.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

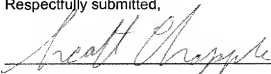
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,



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